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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/495,622	02/01/2000	Richard Leinfellner	4648	5097

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EXAMINER

VAUGHN, GREGORY J

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 02/09/2004

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/495,622

Applicant(s)

LEINFELLNER ET AL.

Examiner

Gregory J. Vaughn

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to application amendment. Application amendment filed on 12/8/2003.
2. Applicant has amended the specification and drawings in response to the objections cited by the examiner in the *Drawings* and *Specification* sections of the previous Office Action (dated 8/13/2003). Applicant's amendment has addressed all objections previously made and therefore, in view of this amendment, objections to the drawings and specification are withdrawn.
3. Applicant has amended the claims in response to the rejections cited by the examiner in the *Claim Rejections – 35 USC § 112* sections of the previous Office Action (dated 8/13/2003). Applicant's amendment has addressed the 35 USC § 112 rejections previously made and therefore, the rejections of claims 8, 12 and 13 made under 35 USC § 112 second paragraph has been withdrawn.
4. Applicant submitted new drawings, which were received on 12/8/2003. These drawings are accepted.
5. Claims 1-21 are pending in the case. Claims 1, 9 and 19 are independent claims.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. Claims 1, 2, 3, 4, 7, 8, 9, 10, 11, 12, 13, 19 and 21 remain rejected under 35 U.S.C. 102(a) as being anticipated by the Help System of the SnagIt software (Version 4.3), by TechSmith Corporation, with an release date of November 14, 1998.
8. **Regarding independent claims 1, 9 and 19**, the SnagIt Help System anticipates the claims.

The SnagIt Help System discloses a method and computer readable medium for sending a message from within an application (see figure 3, *Send Mail (Output)* topic, which describes messaging; figure 4, *Activation SnagIt/32 from Word for Windows* topic, which describes a typical application; figure 5, *Windows Application* topic, which describes other applications; and figure 6 *System Requirements*, which describes a typical computer readable medium wherein the SnagIt system would operate).

The SnagIt Help System discloses receiving a user input to select an image and audio, where image and audio together indicates multimedia (see figure 7, *Changing the Hotkey Combination* topic, which indicates the action the user would take to select an image; and see figure 8 *Audio Format (output Properties)* topic, which describes audio capture information).

The SnagIt Help System discloses generating a message form and adding message information, where the image and the message information are combined (see figure 3, *Send Mail (Output)* topic, which describes the message form as *32-bit MAPI client* and a capability to add an *optional short message*).

The SnagIt Help System discloses sending the composite message (see figure 9 *Sending the Capture to Someone using E-Mail* topic, which discloses the destinations supported for message transmission).

9. **Regarding dependent claims 2, 3, 4 and 7**, the SnagIt Help System discloses the message information to include recipient address information and message text (see figure 10, *Output Properties* dialog box, *Prompt each time* setting), a container to receive the recipient address that is attached to the message for transmission (see figure 10, *Output Properties* dialog box, *Prompt each time* setting), and a method to send the message to a predetermined recipient (see figure 10, *Output Properties* dialog box, *Don't Prompt, Use preset* setting).
10. **Regarding dependent claims 10 and 11**, the SnagIt Help System discloses images combined with audio as a movie (compare Multimedia to movie) (see figure 11, *Video Capture Overview* topic, which discloses *moving images* (paragraph 1, line 1) and *adding audio* (paragraph 2, bullet 2)).
11. **Regarding dependent claims 12, 13 and 21**, the SnagIt Help System discloses the capability to crop images (compare removing extraneous information to crop) (see figure 12, *Crop – Catal80og Viewer Edit Menu* topic); and to scale images to a

smaller size (see figure 13, *Scale - Catalog Viewer Image Menu* topic, which discloses both scaling down and scaling up).

12. **Regarding Dependent claim 8**, dependent claim 8 is rejected for fully incorporating the deficiencies of the base claims.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Dependent claims 5, 6, 16, 17 and 20 remain rejected under 35 U.S.C. 103(a) as being unpatentable over the SnagIt Help System in view of Snook, US Patent 6400378 (filed 9/26/1997).
15. **Regarding dependent claims 5, 6, 16, 17 and 20**, the SnagIt Help System fails to disclose the functionality related to pause and resume of the application. Snook discloses the pausing and resumption of the current application (described as scanning) "The dialog box has a function pause, resume and stop. When the pause button is selected, the scanning process is paused temporarily. The user needs to press the resume button to continue the scanning process" (column 4, lines 26-30).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the SnagIt System to include the pause and resume functionality disclosed by Snook. One of ordinary skill in the art would have been motivated to add pause and resume to the SnagIt system to allow the system user to return to the application at the precise moment the application was interrupted, and to continue to use the application without the loss of interaction with the application.

16. Dependent claims 14 and 15 remain rejected under 35 U.S.C. 103(a) as being unpatentable over the SnagIt Help System in view of Killcommons et al., US Patent 6424996 (filed 11/25/1998).
17. **Regarding dependent claim 14**, The SnagIt Help System fails to disclose the compression of multimedia files. Killcommons discloses "the server will include a processing unit, which may be coupled to the assembly unit or the data interface, configured to encode, compress and/or encrypt the medical data (e.g., prior to the data being assembled into an e-mail package" (column 4, lines 5-9).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the SnagIt System to include the compression of multimedia files. One of ordinary skill in the art would have been motivated to add multimedia file compression to the SnagIt system to permit fast transfers of compressed files to intended recipients.

18. **Regarding dependent claim 15**, the SnagIt Help System discloses a message supported by the *32-bit MAPI mail client* (compare *electronic mail protocol* with *32-bit MAPI mail client*) (see figure 3).
19. Dependent claim 18 remains rejected under 35 U.S.C. 103(a) as being unpatentable over the SnagIt Help System in view of Toyoda, US Patent 6094277 (filed 11/3/1998).
20. **Regarding dependent claim 18**, the SnagIt Help System fails to disclose a confirmation to the sender that the message has been received. Toyoda discloses "E-mail communication method for the Internet facsimile comprising the steps of receiving E-mail from a network, creating identification data from the received mail, creating reply mail including said identification data, and notifying said reply mail to the sender of said received mail" (column 2 lines 12-17).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the SnagIt System to include confirmation notification of the sent message. One of ordinary skill in the art would have been motivated to add confirmation notification so that the sender would be aware of the status of the sent message.

Response to Arguments

21. Applicant's arguments filed December 8, 2003, have been fully considered but they are not persuasive.
22. **Regarding independent claims 1, 9 and 19**, the applicant states: "*SnagIt fails to teach or suggest the limitation of "sending a composite message from within the game application to the intended recipient over a network"*" and "*SnagIt requires that a user exit the application to send a message*" (page 11, third paragraph). The applicant is directed to the rejection of claims 1, 9 and 19 as restated above. In further support of the rejection, the applicant is directed to the "*Hotkey Combination*" topic. SnagIt does not require the user to exit the game application to activate the image capture procedure. The user invokes the SnagIt hotkey from within the game application. When the user is done with the image and the message (i.e. the message is dispatched), SnagIt releases control of the system back to the game application automatically, where the game application is in the same state as when the hotkey was invoked (i.e. the game process had been "paused").
23. **Regarding independent claims 1, 9 and 19**, the applicant states: "*SnagIt fails to teach or suggest generating a message form from within a game application*" (page 11, paragraph 4). The applicant is directed to the rejection of claims 1, 9 and 19 as restated above. In further support of the rejection, the applicant is directed to "*Send Mail*" topic. SnagIt displays a mail form for message information upon invocation of the hotkey.

24. **Regarding dependent claims 5, 6, 14-18 and 20**, the applicant states: *"the Killcommons, Toyoda and Snook references fail to remedy the defects in SnagIt"* (page 12, second paragraph). The applicant is directed to the rejection of the claims as restated above. In further support of the rejections of these claims, see paragraphs 20-22 of this Office Action which provide additional support for the various rejections of limitations found in claims 1, 9 and 19.
25. **Regarding dependent claims**, the applicant states: *"all claims depending from independent claims 1, 9 and 19 are also novel and non-obvious in view of SnagIt"* (page 12, third paragraph). The applicant is directed to the rejection of the dependent claims as restated above. In further support of the rejections of these claims, see paragraphs 20-22 of this Office Action which provide additional support for the various rejections of limitations found in claims 1, 9 and 19.

Conclusion

26. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing

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date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (703) 305-4672. The examiner can normally be reached from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R. Herndon can be reached at (703) 308-5186. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Gregory J. Vaughn
January 26, 2004



STEPHEN S. HONG
PRIMARY EXAMINER